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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,294	02/23/2004	Cathal McPeake	SYB/0095.01	2293

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EXAMINER
PANNALA, SATHYANARAYA R

ART UNIT	PAPER NUMBER
2164	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/708,294	MCPEAKE ET AL.
	Examiner	Art Unit	
	Sathyanarayan Pannala	2164	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 February 2004</u>.

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-67* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some *　c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/28/2005*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   Application No. 10/708294 filed on 2/23/2004 has been examined. In this Office

Action, claims 1-30 are pending.

Information Disclosure Statement

2.   The information disclosure statement (IDS) submitted on 1/28/2005 is in

compliance with the provisions of 37 CFR 1.97 and has been considered by the

examiner.

Priority

3.   Applicant is claiming the benefit of priority under 35 U.S.C. 119(e) since a U.S.

Provisional Application No. 60/481,519 is filed on 10/16/2003. So, the examiner honors

the priority as per statutory law.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly

claiming the subject matter which the applicant regards as his invention.

5.   Claims 20, 44 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of

matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the

conditions and requirements of this title.

7.   Claims 1-67 are rejected under 35 U.S.C. § 101, because none of the claims are

directed to statutory subject matter. Independent claims 1, 25 and 47 merely claiming

nonfunctional descriptive material, i.e., abstract ideas. Even when a claim that recites a

computer that solely calculates a mathematical formula or a computer disk that solely

stores a mathematical formula is not directed to the type of statutory subject matter

eligible for patent protection. The claims are not producing useful, concrete and

tangible results. See Diehr, 450 U.S. at 186 and Gottschalk v. Benson, 409 U.S. 63,

71-72 (1972).

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –.

(e) the invention was described in (1) an application for patent, published under section 122(b), by

another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section

351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2)

of such treaty in the English language.

9.   Claims 1-5, 8-13, 15-29, 32-37, 39-46 are rejected under 35 U.S.C. 102(e) as

being anticipated by Hermansen et al. (US Patent 6,963,871) hereinafter Hermansen.

10.   As per independent claims 1, 25, Hermansen teaches a name searching system

with multiple processing options, which automatically selects and uses an appropriate

cultural-specific set of algorithms to search for database for names and evaluate their

proximity to a query name with multiple processing options (col. 3, lines 53-58).

Hermansen teaches the claimed, determining whether a particular name matches any

names on a list of names, said particular name comprising one or more words (col. 3,

lines 59-3 and col. 4, lines 6-9).   Hermansen teaches the claimed, generating codes

characterizing the particular name by generating a code for each word of the particular

name that is based at least in part on phonetic sounds of the word and on whether

characters of the word match a pattern occurring in a proper name in a given natural language (Fig. 1, col. 10, lines 21-25 and lines 40-51). Hermansen teaches the claimed, deriving an initial set of any matching names by comparing the codes of the particular name against corresponding codes for the list of names (Fig. 1, col. 10, lines 34-39). Hermansen teaches the claimed, deriving a final set of any matching names by comparing words of the particular name against words of names in the initial set (Fig. 2, col. 11, lines 11-16).

11.   As per dependent claims 2, 26, Hermansen teaches the claimed, step of deriving a final set includes calculating a score based upon combinations of words of the particular name and words of names in the initial set (Fig. 3, col. 6, lines 48-50).

12.   As per dependent claims 3, 27, Hermansen teaches the claimed, step of calculating a score is based, at least in part, on how well characters correlate between respective words (col. 2, lines 43-46).

13.   As per dependent claims 4, 28, Hermansen teaches the claimed, step of calculating a score includes determining whether a character at a certain position in a first word is at the certain position in a second word (Fig. 7, col. 9, lines 22-25).

14.   As per dependent claims 5, 29, Hermansen teaches the claimed, step of calculating a score includes determining whether a character at the certain position in the first word is at a different position in the second word (Fig. 7, col. 9, lines 30-33).

15.   As per dependent claims 8, 32, Hermansen teaches the claimed, step of calculating a score includes calculating preliminary scores based on pairing each word of the particular name with each word of a name in the initial set (Fig. 1, col. 5, line 65 to col. 6, line 7).

16.   As per dependent claims 9, 33, Hermansen teaches the claimed, step of calculating a score further comprises calculating an average of at least some of the preliminary scores (Fig. 7, col. 8, lines 56-58).

17.   As per dependent claims 10, 34, Hermansen teaches the claimed, step of deriving a final set further comprises determining whether the score exceeds a threshold (col. 14, lines 37-45).

18.   As per dependent claims 11, 35, Hermansen teaches the claimed, threshold may be established by a user (col. 13, lines 55-57) .

19.   As per dependent claims 12, 36, Hermansen teaches the claimed, step of

deriving a final set is based, at least in part, on length of words of the particular name

and words of names in the initial set (Fig. 7, col. 8, lines 53-55).

20.   As per dependent claims 13, 37, Hermansen teaches the claimed, step of

deriving an initial set includes determining if at least one code generated for the

particular name matches a code for a name on the list of names(Fig. 7, col. 8,

lines 56-58).

21.   As per dependent claims 15, 39, Hermansen teaches the claimed, step of

generating codes includes parsing the particular name into words (Fig. 2, col. 12,

lines 38-40).

22.   As per dependent claims 16, 40, Hermansen teaches the claimed, step of

generating codes includes removing superfluous characters (Fig. 7, col. 9, lines 5-8).

23.   As per dependent claims 17, 20, 41, 44, Hermansen teaches the claimed, step of

generating codes includes equating like-sounding characters (Fig. 8, col. 10,

lines 28-31).

24.   As per dependent claims 18, 42, Hermansen teaches the claimed, step of

generating codes includes generating a single code value based on a plurality of

characters (Fig. 7, col. 8, lines 56-58).

25.   As per dependent claims 19, 43, Hermansen teaches the claimed, step of

generating codes includes examining a character in a word in context of other

characters in the word (Fig. 1, col. 6, lines 8-12).

26.   As per dependent claims 21, 45, Hermansen teaches the claimed, step of

generating codes includes evaluating a plurality of characters to identify particular

patterns of characters (Fig. 7, col. 9, lines 5-8).

27.   As per dependent claims 22, 46, Hermansen teaches the claimed, particular ·

patterns comprise patterns of characters common in particular natural languages

(Fig. 7, col. 9, lines 5-8).

28.   As per dependent claim 23, a computer-readable medium having processor-

executable instructions for performing as per dependent claim 1. This claim is rejected

under the same rationale as claim 1.

29.   As per dependent claim 24, a downloadable set of processor-executable

instructions for performing the method of claim 1. This claim is rejected under the same

rationale as claim 1.

Claim Rejections - 35 USC § 103

30.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

> This application currently names joint inventors. In considering patentability of the claims under 35
> U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly
> owned at the time any inventions covered therein were made absent any evidence to the contrary.
> Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates
> of each claim that was not commonly owned at the time a later invention was made in order for the
> examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior
> art under 35 U.S.C. 103(a).

31.   Claims 14, 38, 47-60, 63-67 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hermansen et al. (US Patent 6,963,871) hereinafter Hermansen, and

in view of Stretton (USPA Pub. 2006/0095368 A1) hereinafter Stretton.

32.   As per dependent claims 14, 38, Hermansen does not explicitly teach suspect

list. However, Stretton teaches the claimed, suspect list (page 4, paragraph [0043]).

Thus, it would have been obvious to one of ordinary skill in the data processing art at

the time of the invention, to have combine the teachings of the cited references because

Stretton's teachings would have allowed Hermansen's method of detecting the

structuring of transactions in a way that alleviates the money laundering activities rely

on watch-lists of suspect individuals and nationalities (page 1, paragraph [0005 &

0007]).

33.   As per independent claim 47, Hermansen teaches a name searching system with

multiple processing options, which automatically selects and uses an appropriate

cultural-specific set of algorithms to search for database for names and evaluate their

proximity to a query name with multiple processing options (col. 3, lines 53-58).

Hermansen teaches the claimed, determining whether a particular name matches any

name on a list, said particular name having one or more words (col. 3, lines 59-3 and

col. 4, lines 6-9).   Hermansen teaches the claimed, generating a code for each word of

said particular name based at least in part on phonetic sound and on patterns of

characters occurring in names in natural languages (Fig. 1, col. 10, lines 21-25 and

lines 40-51). Hermansen teaches the claimed, identifying a set of potentially matching

names by comparing codes generated for said particular name with codes generated for ·

names on the list (Fig. 1, col. 10, lines 34-39). Hermansen teaches the claimed, for

each name in the set of potentially matching names, calculating a score based, at least

in part, upon correlation of characters between words of said particular name and words

of the name (Fig. 3, col. 6, lines 48-50). Hermansen teaches the claimed, if the score

calculated for said particular name and the suspect name exceeds a threshold,

reporting the match to the user (Fig. 3, col. 4, lines 37-40).

Hermansen does not explicitly teach suspect list. However, Stretton teaches the

claimed, suspect list (page 4, paragraph [0043]). Thus, it would have been obvious to

one of ordinary skill in the data processing art at the time of the invention, to have

combine the teachings of the cited references because Stretton's teachings would have

allowed Hermansen's method of detecting the structuring of transactions in a way that

alleviates the money laundering activities rely on watch-lists of suspect individuals and

nationalities (page 1, paragraph [0005 & 0007]).

34.   As per dependent claim 48, Hermansen and Stretton combined teaches

claim 47. Stretton teaches the claimed the suspect list comprises a watch list (page 4,

paragraph [0043]). Thus, it would have been obvious to one of ordinary skill in the data

processing art at the time of the invention, to have combined the teachings of the cited

references because Stretton's teachings would have allowed Hermansen's method of

detecting the structuring of transactions in a way that alleviates the money laundering

activities rely on watch-lists of suspect individuals and nationalities (page 1, paragraph

[0005 & 0007]).

35.   As per dependent claim 49, 54, Hermansen teaches the claimed, step of
generating a code includes parsing said particular name into words (Fig. 2, col. 12,
lines 38-40).

36.   As per dependent claim 50, Hermansen teaches the claimed, step of generating
a code includes removing superfluous characters (Fig. 7, col. 9, lines 5-8).

37.   As per dependent claim 51, Hermansen teaches the claimed, step of generating
a code includes equating like-sounding characters (Fig. 8, col. 10, lines 28-31).

38.   As per dependent claim 52, Hermansen teaches the claimed, step of generating
a code includes generating a single code value based on a plurality of characters (Fig.
7, col. 8, lines 56-58).

39.   As per dependent claim 53, Hermansen teaches the claimed, step of generating
a code includes examining a character in a word in context of other characters in the
word (Fig. 1, col. 6, lines 8-12).

40.   As per dependent claim 55, Hermansen teaches the claimed, step of generating
a code includes evaluating a plurality of characters to identify particular patterns of
characters (Fig. 1, col. 6, lines 8-12).

41.   As per dependent claim 56, Hermansen teaches the claimed, particular patterns

comprise patterns of characters common in particular natural languages (Fig. 7, col. 9,

lines 5-8).

42.   As per dependent claim 57, Hermansen teaches the claimed, step of calculating

a score includes calculating preliminary scores based on pairing each word of said

particular name with each word of the suspect name (Fig. 1, col. 5, line 65 to col. 6,

line 7).

43.   As per dependent claim 58, Hermansen teaches the claimed, step of calculating

a score includes calculating an average of at least some of the preliminary scores

(Fig. 7, col. 8, lines 56-58).

44.   As per dependent claim 59, Hermansen teaches the claimed, step of calculating

a score includes comparing a character at a certain position in a first word with a

character at the certain position in a second word (Fig. 7, col. 9, lines 22-25).

45.   As per dependent claim 60, Hermansen teaches the claimed, step of calculating

a score further comprises determining whether the character at the certain position of

the first word is at a different position in the second word (Fig. 7, col. 9, lines 30-33).

46.   As per dependent claim 63, Hermansen teaches the claimed, step of calculating

a score is based, at least in part, on length of words of said particular name and the

suspect name (Fig. 7, col. 8, lines 53-55).

47.   As per dependent claim 64, Hermansen teaches the claimed, step of calculating

a score is based, at least in part, on number of words of said particular name and the

suspect name (col. 2, lines 43-46).

48.   As per dependent claim 65, Hermansen teaches the claimed, step of reporting

the match includes reporting the score calculated for said particular name and the

suspect name (col. 14, lines 37-45).

49.   As per dependent claim 66, a computer-readable medium having processor-

executable instructions for performing As per dependent claim 47. This claim is

rejected under the same rationale as claim 47.

50.   As per dependent claim 67, a downloadable set of processor-executable

instructions for performing the method of claim 47. This claim is rejected under the

same rationale as claim 47.

Allowable Subject Matter

51.   Claims 6-7, 30-31, 61-62 are objected to as being dependent upon a rejected

base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sathyanarayan Pannala whose telephone number is

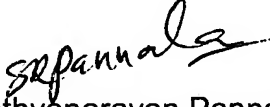(571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

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571-272-1000.

Sathyanarayan Pannala
Primary Examiner

srp
December 23, 2006